

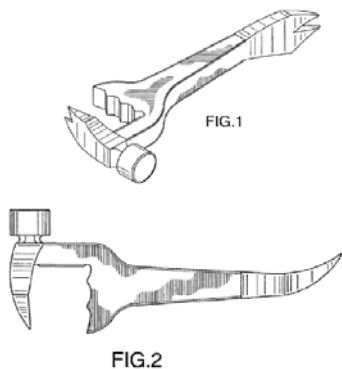
Intellectual Property Client Service Group

To: Our Clients and Friends

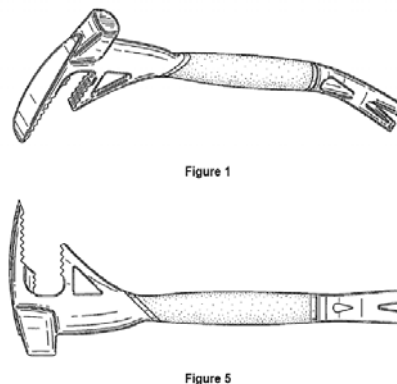
March 15, 2010

Richardson v. Stanley Works, Inc. – The Federal Circuit concludes that, where a patent design includes both functional and ornamental elements, the claim scope is limited to the ornamental aspects.

In *Richardson v Stanley Works, Inc.*, No. 2009-1354 (Fed. Cir., March 9, 2010), Richardson sued tool- and hardware-maker Stanley, claiming that Stanley's multi-functional utility bar, known as the "FuBar," infringed Richardson's design patent covering his multi-functional tool, the "Stepclaw."



Richardson's "Stepclaw"



Stanley's "FuBar"

As part of claim construction, the District Court distinguished the ornamental aspects (*e.g.*, tapering and contouring of various elements) from the purely functional aspects (*e.g.*, the length of the handle, the flat hammerhead, and the positioning of the jaw and crowbar) of Richardson's design, and held that the ordinary observer, after discounting the functional elements, would not be deceived into thinking that the FuBar tool was the same as the Stepclaw.

Richardson argued on appeal that the District Court erred in divorcing the functional elements from the ornamental aspects. Specifically, Richardson claimed that the Federal Circuit’s decision in [Egyptian Goddess v. Swisa, Inc.](#), 543 F.3d 665 (Fed. Cir. 2008), required the patent design to be compared in its entirety with the accused design.

The Federal Circuit disagreed, holding that [Egyptian Goddess](#) did not alter long-standing precedent that “design patents are limited to the ornamental aspects alone and do not extend to any functional elements of the claimed article.” Rather, [Egyptian Goddess](#) held that the “ordinary observer” test was the sole test for design patent infringement; thus, “the patentee must establish that an ordinary observer, familiar with the prior art designs, would not be deceived into believing that the accused product is the same as the claimed design.” Among the claim scope issues to consider are the “distinction[s] between the functional and ornamental aspects of the design.”

Ignoring the functional aspects, the Federal Circuit then made critical distinctions between the non-functional features of the two designs. This included the “streamlined visual theme,” the “tapered hammer-head,” and the “contoured handle” of the FuBar vis-à-vis the Stepclaw. Based on these features, Stanley’s FuBar embodied an “overall effect” that was not deceptively similar to the claimed design, and thus infringement could not be found.

This case highlights the importance of analyzing the functional and ornamental aspects of patented designs to determine the scope of protection. Even close similarity between functional aspects of patented and accused designs will not warrant a finding of infringement, if the respective ornamental aspects are sufficiently dissimilar.

To discuss this issue further, please contact any of the following members of Bryan Cave’s [Intellectual Property Client Service Group](#):

Kara E.F. Cengar
(312) 602-5019
kara.cengar@bryancave.com

George C. Chen
(602) 364-7367
george.chen@bryancave.com

J. Bennett Clark
(314) 259-2418
ben.clark@bryancave.com

Daniel A. Crowe
(314) 259-2619
dacrowe@bryancave.com

Stephen P. Gilbert
(212) 541-1236
spgilbert@bryancave.com

Stephen M. Haracz
(212) 541-1271
smharacz@bryancave.com

Edward J. Hejlek
(314) 259-2420
edward.hejlek@bryancave.com

Kevin C. Hooper
(212) 541-1266
kchooper@bryancave.com

Lawrence G. Kurland
(212) 541-1235
lgkurland@bryancave.com

Robert G. Lancaster
(310) 576-2239
rglancaster@bryancave.com

K. Lee Marshall
(314) 259-2135
kmarshall@bryancave.com

Ryan Tyler Pumpian
(404) 572-6851
ryan.pumpian@bryancave.com

Joseph Richetti
(212) 541-1092
joe.richetti@bryancave.com

David A. Roodman
(314) 259-2614
daroodman@bryancave.com

Charles L. Warner
(404) 572-6718
charles.warner@bryancave.com